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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,286	07/25/2006	Kiyoung Kim	105-06	6943

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EXAMINER	
DAVIS, DEBORAH A	

ART UNIT	PAPER NUMBER
1655	

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11/20/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/587,286	KIM, KIYOUNG	
	Examiner	Art Unit	
	DEBORAH A. DAVIS	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 July 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-4,7,8,11,12,15 and 16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-4,7,8,11,12,15 and 16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicants' response to the Office Action mailed on April 29, 2008 has been acknowledged. Currently, claims 3,-4, 7-8, 77-12, 15-16, and 17-22 pending, which includes newly added claims 17-22. Claims 1, 5-6, 9-10, and 14 have been cancelled.

Election/Restrictions

Newly submitted claims 17-22 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The new claims are drawn to different methods of treating kidney function, liver function and fibrosis, by administering a composition comprising Hovenia dulcis Thunb and/or Lindera obtusiloba as active ingredients. In contrast, the original claims are drawn to a composition comprising Hovenia dulcis Thunb and/or Lindera obtusiloba as active ingredients. The claims are independent and distinct because the prior art beneficially teaches the compositions can be used in other processes disclosed below. In addition, the claims are drafted as independent claims.

Therefore, since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 17-22 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3-4, 7-8, 11-12 and 15-16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kuk Hyun Shin (KR 214801) in view of Jeong-Yong et al, (Korean J. Food Science Technology, 2000, Vol. 32, No 6, page 1403) for reasons of record and restated below:

The claims are drawn to a composition comprising Lindera obstiloba ingredient and Hovenia dulcis Thunb extracts as active ingredients.

The reference of Shin beneficially teaches a composition comprising extracts from the stem of Lindera obtusiloba and preparations thereof providing excellent antibacterial (i.e. antimicrobial) effects (see entire abstract).

The reference of Jeong-Yong et al, beneficially teaches a methanol extract from Hovenia dulcis Thunb as an active ingredient that provides antioxidative and antimicrobial activity (see entire abstract).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the instant ingredients for their known benefit (i.e., to antimicrobial, antioxidant properties) since each is well known in the art for the same purpose and for the following reasons. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the

instant ingredients for their known benefit since each is well known in the art for the same purpose (e.g., having antimicrobial, antioxidant properties) and for the following reasons. It is well known that it is prima facie obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. In re Kerkhoven, 626 F.2d 846, 850, 205 U.S.P.Q. 1069 (CCPA 1980); In re Sussman, 1943 C.D. 518; In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960). This rejection is based on the well established proposition of patent law that no invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients. The result-effective adjustment of particular working conditions (e.g. determining suitable ratios of such extracts therein) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Response to Arguments

Applicant's arguments filed July 28, 2008 have been fully considered but they are not persuasive.

Applicant argues that is no teaching or suggestion in the cited references for a composition comprising both Lindera obtustiloba and Havenia duclis Thunb extracts. Applicant argues that the cited references are not useful for the same purpose in order to form a third composition useful for the same purpose. Applicant argues that the cited refererence of Shin teaches Lindera obtusiloba has antibactrial effects on Pseudomonas aeruginose and Staphylococcus aeruginosa strains and the cited reference of Jeong-Yong teaches Hovenia dulcis Thunb which demonstrated antimicrobial activity. Applicant argues that the instant claims discloses a composition comprising an herbal mixture of Lindera obtustiloba and Havenia dulcis Thunb which provides the effects of anti-fibrosis and improving kidney function which is not disclosed in the cited references. Applicant concludes that the two cited references clearly do not have the same purpose in the art as instantly claimed. These arguments have been fully considered but not found to be persuasive of error.

In response, it is known in the art to combine two ingredients useful for the same purpose to form a third composition. The reference of Shin teaches that Lindera obtusiloba has antibacterial properties and the cited reference of Jeong-Yong teaches Hovenia dulcis Thunb has antimicrobial properties. Thus, both compositions of Lindera obtusiloba and Hovenia dulcis are useful for the same purpose of having antimicrobial and antibacterial properties. The fact that applicant has recognized another advantage

which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicant argues that the herbal mixture, that includes both Lindera obtusiloba and Hovenia dulcis Thunb, of the present application has effects that are greater than the additive effect of the ingredients alone and directs the examiner to Table 2 and Table 3 of the instant specification. These arguments have been fully considered but not found to be persuasive of error.

In response, there does not appear to be a clear demonstration of synergism. The group in Table 2 that was treated with Lindera obtusiloba did not show a level of total bilirubin compared to the group that was treated with Hovenia dulcis Thunb and the group treated with the herbal mixture (that includes both Lindera obtusiloba and Hovenia dulcis Thunb). Moreover, the group that was treated with Hovenia dulcis Thunb and the group that was treated with Lindera obtusiloba only demonstrated a slight difference in bilirubin levels. In Table 4, the group treated with Lindera obtusiloba appeared to demonstrate a lower lipid peroxidation level in kidney tissues compared to the group treated with the herbal mixture. Therefore, in the examiner's view, Tables 2, and 4, does not show clear synergism of the herbal mixture compared to the groups treated with Lindera obtusiloba and the group treated with Hovenia dulcis Thunb alone. Thus, the cited references are still deemed obvious over the instant claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBORAH A. DAVIS whose telephone number is (571)272-0818. The examiner can normally be reached on 8-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Deborah A. Davis
Patent Examiner, AU 1655
November 2008

/Christopher R. Tate/
Primary Examiner, Art Unit 1655